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Supreme Court, U.S.
FILED
MAY 5 1999
CLERK

No. 98-1500

IN THE

# Supreme Court of the United States

WEST PUBLISHING CO. and
WEST PUBLISHING CORPORATION,

*Petitioners,*

*v.*

MATTHEW BENDER & COMPANY, INC.
and HYPERLAW, INC.,

*Respondents.*

ON PETITION FOR WRIT OF CERTIORARI
TO THE UNITED STATES COURT OF APPEALS
FOR THE SECOND CIRCUIT

## REPLY BRIEF FOR PETITIONERS

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## PRELIMINARY STATEMENT

West Publishing Company and West Publishing Corporation (collectively, "West") respectfully submit this reply brief, pursuant to Supreme Court Rule 15(6), in further support of their petition for certiorari in this case and in response to the briefs filed by respondents Matthew Bender & Company, Inc. ("Bender") and HyperLaw, Inc. ("HyperLaw").

Bender's brief, filed on or about April 29, 1999 ("Bender Br."), does not oppose but, rather, joins in West's request that a writ of certiorari be issued to review the opinion and decision of the United States Court of Appeals for the Second Circuit entered in this case. Bender Br. at 1. It is therefore unnecessary to respond at this time to most of the points raised by Bender, which has taken this opportunity to argue the merits of the case (and to include irrelevant material and meritless attacks on West). HyperLaw's brief ("HyperLaw Br.") was filed on or about April 19, 1999.[1]

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1. HyperLaw, the sole respondent in Case No. 98-1519, has filed no opposition to West's petition in that case, which addresses HyperLaw's copying from West of editorial revisions, additions, and annotations to judicial opinions (in the same CD-ROM product that features a copy of West's original arrangement).

## ARGUMENT

### I.

### BENDER AND HYPERLAW BOTH IGNORE OR OBFUSCATE THE IMPORTANT QUESTIONS OF STATUTORY CONSTRUCTION RAISED IN THIS PETITION

West's petition ("Pet.") amply demonstrates that, as Judge Sweet stated in his Second Circuit dissent, the unique "technological capacity" of CD-ROM technology "presents a new question," and the erroneous answer to that question in the majority opinion "threatens to eviscerate copyright protection for compilations." 158 F.3d at 710, Pet. App. 42a. Bender and HyperLaw would have this Court believe, however, that this case has nothing to do with CD-ROM technology or statutory construction — notwithstanding the fact that the Second Circuit majority opinion devotes fifteen pages (over half of the "Discussion") to an attempt at reconciling CD-ROM technology with the majority's interpretation of the 1976 Copyright Act (Pet. App. 19a-34a).

HyperLaw never even refers to the technological or statutory issues. Bender declares that "this case does not turn on" the nature of CD-ROM technology, and has no special implications for electronic and computer technology (Bender Br. at 26), but offers no basis for these conclusory assertions. Indeed, although West's petition details those particular features of CD-ROM technology, overlooked or misapprehended by the Second Circuit, that raise important questions of statutory interpretation (*see* Pet. at 15-26), Bender does not attempt to refute any of these technological

realities. Thus, Bender effectively admits, for example, that: (i) the physical storage arrangement of CD-ROM data is irrelevant to the issue of perceivable arrangement(s); (ii) no arrangement of data, including a chronological one, is perceivable on a CD-ROM without "manipulation of the data" by the user; and (iii) no CD-ROM user can ever alter the "fixed embedding of the work."[2]

Yet Bender makes no effort to reconcile these realities with the Second Circuit's interpretations of key statutory terms, which are explicitly founded on erroneous presumptions about CD-ROMs. Instead, in circular fashion, Bender's simplistic arguments merely reiterate those presumptions.[3]

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2. Respondents' failure to dispute West's characterization of any of these technological features is especially telling in light of Supreme Court Rule 15(2), which states in part: "Counsel are admonished that they have an obligation to the Court to point out in the brief in opposition, and not later, any perceived misstatement made in the petition." (The Rules do not impose the same requirement on reply briefs, which must be filed within a short time-frame, and this reply therefore addresses only a few of the misstatements made in respondents' briefs.)

3. For example, Bender, echoing the Second Circuit's fundamental misapprehension about CD-ROM technology, asserts that West's arrangement cannot be featured in Bender's product because the product "stores and displays a different arrangement." Bender Br. at 4, n.2. Similarly, although Bender does not deny that user manipulation is required to access any CD-ROM arrangement (*i.e.*, no arrangement is shown simply by plugging in a machine), it reiterates the Second Circuit's definition of a CD-ROM "copy" — which erroneously assumes that the CD-ROM machine itself, rather than a user, "reads" a CD-ROM arrangement. *See* Bender Br. at 28-29.

Indeed, although Bender's brief vainly attempts to suggest that this case is about nothing more than page numbers and jump cites, and conveniently ignores the systematic character of respondents' copying, it succeeds only in highlighting the confusion surrounding the applicability of the 1976 Act to CD-ROM technology, and the need for the Court's guidance in this regard. Bender claims that West's — and Judge Sweet's — interpretation and application of the statutory definition of "copies" in 17 U.S.C. § 101 is "eroneous" [sic]. Bender Br. at 27. Yet, as West has demonstrated (Pet. at 23-26), and Bender does not refute, the Second Circuit's interpretation of "copies" effectively rewrites the statute to require that the work must be perceived *by* a machine, not, as Congress stated, "with the aid of a machine or device."[4] West's interpretation, on the other hand, is completely consistent with the statutory language and, in keeping with legislative intent, can be meaningfully applied to technologies, like CD-ROMs, that were not yet known when the statute was enacted.[5]

4. The Second Circuit would find CD-ROM infringement of a copyrighted arrangement only when the "machine or device that reads" the CD-ROM disc "perceives the embedded material in the copyrighted arrangement or in a substantially similar arrangement." 158 F.3d at 701, Pet. App. 20a. But, as Bender has effectively admitted, no machine "perceives" any arrangement on a CD-ROM; however, "with the aid of a machine or device," a user can readily perceive one or more CD-ROM data arrangements if the manufacturer has made the arrangement accessible by pre-programming.

5. As Judge Sweet observed in his dissent, "[h]ere again it is necessary to reconcile technology with pre-electronic principles of law." 158 F.3d at 710, Pet. App. 42a. Both Bender and the Second Circuit, however, ignore the open-ended, forward-looking language of the statute and would limit its application to situations that are strictly analogous to the piano-roll dilemma raised over 90 years ago by *White-Smith Publishing Co. v. Apollo, Co.*, 209 U.S. 1 (1908). *See* Bender Br. at 27-28.

The resolution of this federal question, which indisputably has far-reaching implications for many sectors of the information industry and the public, is precisely the kind of issue that is appropriate for this Court's consideration.[6]

## II.

## RESPONDENTS' BRIEFS DO NOT REFUTE THE SPLIT OF AUTHORITY BETWEEN THE CIRCUITS

Bender ultimately concedes, after much hemming and hawing, that "a split of authority now exists as a practical matter" between the Second and Eighth Circuits with regard to whether systematic and comprehensive electronic star pagination constitutes infringement of West's original case arrangements. Bender Br. at 20. Bender acknowledges that the Eighth Circuit's opinion "has continued to enjoy post-*Feist* vitality in the Eighth Circuit," and that the district court in *Oasis Publishing Company v. West Publishing Co.*, 924 F. Supp. 918, 923 (D. Minn. 1996) held that "*Feist* did not overrule" *West Publishing Co. v. Mead Data Central, Inc.*, 799 F.2d 1219 (8th Cir. 1986), *cert. denied*, 479 U.S. 1070, 107 S. Ct. 962 (1987).[7]

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6. Bender's request for a "summary affirmance" of the Second Circuit's ruling is a transparent attempt to avert this Court's analysis of the serious and substantive issues of statutory interpretation raised by digital technology. Indeed, all three judges on the Second Circuit panel in this case recognized the need to address these issues.

7. HyperLaw, by contrast, simply ignores the reasoning and holdings in *Oasis* so that it can pretend that there has been no post-

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However, the suggestion that this split should be resolved to prevent West from using what Bender gratuitously and pejoratively refers to as a "scarecrow" copyright to "dissuade others from offering judicial opinons [sic] with star pagination references" (Bender Br. at 12-17, 21-26, 30) is specious on its face. The validity of the "scarecrow" patent in *Wembley, Inc. v. Superba Cravats, Inc.*, 315 F.2d 87, 89 (2d Cir. 1963), cited by Bender,[8] had never been upheld by any court, or endorsed by any judge, in any jurisdiction; indeed, the Second Circuit defined a "scarecrow" patent as one that, by the patentee's design, never would come before any tribunal for review. In dramatic and complete contrast, West's right to protection from infringement by the systematic and comprehensive copying of arrangement markers has been validated by a decision of the Court of Appeals, two district court rulings (before and after *Feist*), and a vigorous dissent by Judge Sweet in this post-*Feist* case.[9]

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*Feist* reaffirmation of *West v. Mead*'s analytical approach in the Eighth Circuit. HyperLaw also distorts the facts when it asserts that one of West's attorneys, Arthur R. Miller, is among those scholars who "have determined that West Publishing was overruled by *Feist*." HyperLaw Br. at 7 and n.5. In fact, the article cited by HyperLaw merely states that *Feist* "raises questions" concerning *West v. Mead* and does not suggest how those questions would or should be answered.

8. Bender's citation of 315 F.2d 87, 98 is erroneous.

9. Bender makes misleading references to West's use of star pagination to "rival sources," as if West does what Bender and HyperLaw seek to do — *i.e.*, use the copyrighted arrangements of other publishers without permission. *See, e.g., Bender* Br. at 29, n.20. What Bender neglects to mention, of course, is that public domain arrangements (like that in *U.S. Reports*) can be used by anyone, and that publishers — West and others — frequently license the use of arrangements through star pagination.

Under the circumstances, Bender's characterization of West's claim to copyright protection as "fantastic" (Bender Br. at 21) is an offense to the judges who have ruled or opined otherwise as well as to West and its counsel.[10] The fact that some other judges, scholars, and government attorneys disagree with West's position does not, as Bender arrogantly suggests, somehow deprive West of the right to defend its copyright.[11] Moreover, although Bender attempts to portray West as going to great lengths to avoid further judicial review of its copyright (Bender Br. at 21-26), so as to preserve the "split" between the Circuits, this smear is flatly contradicted by the fact that it was West's choice, and West's alone, to seek this Court's resolution of the issue.[12]

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10. Respondents' reliance on hyperbolic slurs and attacks throughout this litigation is also reflected in HyperLaw's attempt to cast doubt on the integrity of the Justices of this Court (HyperLaw Br. at 9-11), a terror tactic that is unworthy of discussion.

11. Nor is there any authority for Bender's apparent claim (Bender Br. 15-16) that West's copyright should be eviscerated because of the usefulness, popularity, or governmental approval of West's reporters as a citation source. On the contrary, the courts have consistently rejected purported "public benefit" arguments for eliminating copyright protection. *See, e.g., CCC Information Services, Inc. v. Maclean Hunter Market Reports, Inc.*, 44 F.3d 61, 74 (2d Cir. 1994) (noting that dedication of private intellectual property to public could amount to an unconstitutional taking), *cert. denied*, 516 U.S. 817 (1995); *Practice Management Information Corp. v. American Medical Ass'n*, 121 F.3d 516, 518-20 (9th Cir.) (refusing to invalidate copyright of publicly adopted codes), *cert. denied*, 118 S. Ct. 339 (1997).

12. In other respects, too, Bender distorts the record in an apparent attempt to cast aspersions on West and distract from the

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## CONCLUSION

For the foregoing reasons, West respectfully requests that a writ of certiorari to the United States Court of Appeals for the Second Circuit be granted.

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important issues involved. For example, although even HyperLaw acknowledges that both lower courts assumed, for purposes of adjudication, that West's reporters feature a "copyrightable arrangement" (HyperLaw Br. at 3), Bender takes the astonishing position that the district court never assumed, even *arguendo*, that West's case arrangement is protectible. Bender Br. at 8, n.6. In fact, this specific assumption is unambiguously reaffirmed throughout the district court record; for example, the court refers to West's "creative activity" as "decid[ing] that a group of cases should be compiled together in a certain order," and states that West's works are copyrightable compilations "[t]o the extent that they [West] made selections of what order in which they are going to put the opinions." Pet. App. 50a, 59a. Similarly, Bender suggests that the district court did not assume that West's arrangement (and protectible portions thereof) can be readily perceived through the pre-programming of respondents' CD-ROM products. Bender Br. at 8, n.6. Again, the record leaves no doubt that all of West's assertions about the capability of the CD-ROM products were, without objection from respondents, assumed to be true for purposes of the summary judgment motion. *See, e.g.*, Pet. App. 55a, 76a-77a.

Respectfully submitted,

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